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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,731	11/04/2003	Chan-Tung Chen	3624-0137P	6430

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EXAMINER
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CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/699,731	Applicant(s) CHEN, CHAN-TUNG 	
	Examiner Mike Chambers	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/09/04 paper.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 1-10 is acknowledged.

Applicant's argument is that it is not an undue burden to examine all claims. As noted in the prior action, claims 11-20 are drawn to a method of making which is classified in a different art unit and technological area. This is considered an undue burden.

Because these inventions are distinct and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated was proper. This restriction is made final. Claims 11-20 are withdrawn from further examination, as directed to claims non-elected, 37CFR1.142.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities:

In line 2: "water" should be ~~metal~~.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (6431995). Jackson discloses a body, a striking plate being adapted to be mounted to the body; a hosel, a shaft being adapted to be engaged with the hosel; and

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a heel formed between the striking plate and the hosel, the heel including at least one opening for improving casting quality of the golf club head (fig 1,3).

As to claim 2 : Jackson discloses an opening (fig 3).

As to claim 3 : Jackson discloses an opening (fig 3). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 4-9 : Jackson discloses a golf club (fig 1). The limitation claimed by the applicant refers to a product by process limitation. Jackson meets the structural limitations of the claim because it achieves the same final product.

As to claim 10 : Jackson discloses a uniform wall thickness. (fig 3).

Also,

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (5695409). Jackson discloses a body, a striking plate being adapted to be mounted to the body; a hosel, a shaft being adapted to be engaged with the hosel; and a heel formed between the striking plate and the hosel, the heel including at least one opening for improving casting quality of the golf club head (fig 1,7).

As to claim 2 : Jackson discloses an opening (fig 1).

As to claim 3 : Jackson discloses an opening (fig 7). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 4-9 : Jackson discloses a golf club (fig 1). The limitation claimed by the applicant refers to a product by process limitation. Jackson meets the structural limitations of the claim because it achieves the same final product.

As to claim 10 : Jackson discloses a uniform wall thickness (fig 3).

Also,

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Magamoto et al (5451048). Magamoto discloses a body, a striking plate being adapted to be mounted to the body; a hosel, a shaft being adapted to be engaged with the hosel; and a heel formed between the striking plate and the hosel, the heel including at least one opening (fig 5).

As to claim 2 : Magamoto discloses an opening (fig 5).

As to claim 3 : Magamoto discloses an opening (fig 5). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 4-9 : Magamoto discloses a golf club (fig 1,5). The limitation claimed by the applicant refers to a product by process limitation. Jackson meets the structural limitations of the claim because it achieves the same final product.

As to claim 10 : Magamoto discloses a uniform wall thickness (fig 5).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5451048\*5695409\*6431995

Michael Chambers  
Examiner  
Art Unit 3711

February 9, 2005

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700